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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
20009.0077US01 (BS01-231)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]
on April 24, 2006
Signature
Typed or printed name Jeramie J. Keys

Application Number	Filed
09/965,398	September 28, 2001

First Named Inventor
Baker et al.

Art Unit	Examiner
2642	Chiang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 42,724
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature
Jeramie J. Keys
Typed or printed name
678-565-4748
Telephone number
April 20, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Baker	Examiner:	Chiang
Serial No.:	09/965,398	Group Art Unit:	2642
Filed:	September 28, 2001	Docket No.:	20009.0077US01 (BS01-231)

Title: TELEPHONE WITH REMOVABLE DSL CARTRIDGE

CERTIFICATE UNDER 37 CFR 1.8:
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 24, 2006.

By: _____
Name: Jeramie J. Keys

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In conjunction with a Notice of Appeal, reconsideration and allowance of the application is respectfully requested for at least the following reasons. The Notice of Appeal is being filed in response to a final Office Action mailed on October 27, 2005, as well as an Advisory Action mailed on February 24, 2006. The period for response has been extended by the concurrently filed Petition.

It should be noted that the Advisory Action incorrectly states that the after final response was filed on January 3, 2006. Because the certificate of mailing procedure was used, the filing date of that response was the mailing date of December 27, 2004 rather than the date upon which the response was received by the Office. Accordingly, the period of time for extensions runs from the mailing date of the Advisory action, such that only a 2 month extension is necessary.

According to exemplary embodiments, a telephone includes a filter cartridge. A first connector on one side of the filter cartridge receives incoming signals, including both POTS and DSL signals via one connector on one end (i.e., the external end) while also outputting the DSL signal via another connector on this same end and while passing the POTS signal through another connector on another end (i.e., the internal end). Thus, a wall jack carrying a combined POTS and DSL signals may be plugged into the phone, the phone then outputs the DSL signal so that it can be routed to a DSL modem while the POTS signal is passed into the internal circuitry of the phone for handling ordinary POTS telephone calls. Thus, a separate external cartridge is not needed to separate POTS and DSL signals from the signal of the wall jack.

According to other exemplary embodiments, a filter cartridge for insertion into a socket of a telephone provides the two connectors on the one end (i.e., the external end), where one receives the POTS and DSL signals from the wall jack and where the other outputs the DSL signal. Furthermore, the filter cartridge provides the connector on the other end (i.e., the internal end) to pass the POTS signals out for reception by the POTS circuitry of the telephone.

1. The Madsen reference does NOT show a filter cartridge inserted in a phone, with POTS in one side and POTS out of the other side of the filter cartridge

In relation to claim 1, this claim recites a telephone comprising, among other things, POTS circuitry and a filter cartridge with a first end and a second end, the first end being inserted into the location within the housing of the telephone. Claim 1 further recites the first end having a connector for engaging the POTS circuitry and the second end having a first connector for receiving a DSL line and a second connector for receiving a telephone line, wherein the second end is configured to accept the DSL line and the telephone line simultaneously. Claim 1 additionally recites wherein the filter cartridge comprises circuitry to receive a signal through the at least one second connector of the second end that contains both DSL and POTS signal to filter the DSL signal out so as to pass substantially only the POTS signal to the at least one electrical connector of the first end, and to simultaneously pass the DSL signal to the at least one first connector of the second end for receiving the DSL line.

Thus, the filter cartridge of claim 1 is inserted into the telephone, where the telephone has POTS circuitry, and the electrical connector of the inserted end of the filter cartridge is passed the POTS signal. The non-inserted end of the filter cartridge has the first connector that connects to the DSL line and the DSL signal is passed to this first connector while the second connector is connected to the telephone line to receive the signal containing both the DSL and POTS signals. This allows the circuitry of the filter cartridge to then pass the DSL signal to the first connector of the second (non-inserted) end while passing the POTS signal to the connector of the first (inserted) end.

The previous Office Actions have stated that Madsen discloses a cartridge (52) having a first end (56) and a second end (72), where the first end (56) includes at least one connector for the POTS circuitry. Applicants completely disagree. Apparently, the Office Action is stating that the end 56 connects to POTS circuitry of a computer, since card 52 is a PCMCIA card that plugs into a PCMCIA slot of a computer. Applicants continue to dispute this conclusion.

The error in this rejection appears to be in failing to recognize that a PCMCIA card 52 that receives a POTS signal on its external end 72 must then convert that signal to a PCMCIA signal to be output via end 56 which is connected to a PCMCIA bus of a computer. A PCMCIA bus of a computer is NOT POTS circuitry. To the contrary, the PCMCIA bus is a data bus that operates upon a much smaller voltage magnitude (3-5V) than POTS (-48V) and uses a data bus protocol other than the signaling protocol of POTS. In other words, a POTS signal and a PCMCIA signal are entirely different. To account for this difference, a PCMCIA modem (such as modem 52 of Madsen) is used to convert a POTS signal being received on the external side 72 into a PCMCIA signal to be output on the internal side 56. If a POTS signal would work upon a PCMCIA bus of a computer, then there would never be a need for a PCMCIA modem since the POTS signal would not need to be converted. However, the mere fact that PCMCIA modems do exist is proof that a POTS signal cannot be fed to a PCMCIA bus, and indeed, the modem 52 of Madsen acts to convert a POTS signal at end 72 into a PCMCIA signal at end 56.

Because Madsen involves a PCMCIA card that MUST output a PCMCIA signal to a PCMCIA bus via end 56, Madsen is entirely different than recitations of claim 1.

Madsen completely fails to disclose a POTS signal plus DSL signal being received via one end of a filter cartridge and that the POTS signal is then output via the other end of the filter cartridge in order to provide it to POTS circuitry. Corning fails to disclose a phone having a filter cartridge inserted therein but instead shows a plate for mounting to a wall jack in order to filter DSL from POTS signals. Thus, neither reference singly or in combination discloses the claim recitations.

At least for these reasons, claim 1 and its dependents are allowable over Madsen in view of Corning. Furthermore, independent claims 7 and 11 include similar recitations regarding the filter cartridge for insertion into the telephone with the connector on the inserted end for passing POTS signals, the connector on the non-inserted end for receiving the POTS plus DSL signals, and the connector on the non-inserted end for outputting the DSL signals. Thus, these claims and their dependents are allowable over Madsen in view of Corning for at least these reasons as well.

2. There is no motivation to modify Madsen to output a POTS signal to the computer

In addition to neither Madsen nor Corning disclosing the recitations of the claims, there is no motivation to modify Madsen by Corning. As noted above, Madsen fails to disclose that there is a POTS signal being output from the inserted end. As discussed, the PCMCIA card 52 of Madsen MUST output a PCMCIA signal via the end 56 in order to communicate over the PCMCIA bus of the computer upon which the PCMCIA card 52 is plugged into. There can be no motivation to modify Madsen to output POTS signals in place of the PCMCIA signals because POTS signals simply do not work on a PCMCIA bus. As noted above, the whole purpose of a computer modem is to convert a POTS signal into a signal that is operative on a computer. For example, a PCI modem card converts a POTS signal to a PCI bus signal, which is of an entirely different voltage and signaling protocol than POTS. Likewise, a PCMCIA modem as in Madsen converts a POTS signal to a PCMCIA bus signal, which is also of an entirely different voltage and signaling protocol than POTS.

Thus, should Madsen be modified to remove the POTS to PCMCIA conversion as would be required for such a rejection, any POTS signal output from end 56 of card 52

would result in an inoperable communication card 52 since the voltages and protocols are entirely different. Furthermore, modifying Madsen in this manner would likely damage if not destroy the PCMCIA bus of the computer since the POTS signal has a voltage that is about 10 times greater than that of a PCMCIA bus. In the Advisory Action, the Examiner has requested that the Applicant show the examiner specifically why connecting a -48 Volt POTS output into a 3V PCMCIA bus would overload the PCMCIA bus and render it inoperable. Applicants submit that inoperability and/or damage due to a 10 fold increase in operating voltage of a data bus speaks for itself. Applicants further submit that a POTS protocol being different than a PCMCIA protocol and not functioning on a PCMCIA data bus of a computer also speaks for itself.

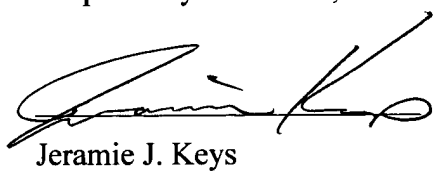
Accordingly, as there can be no motivation to modify Madsen as would be required to sustain the 103 rejection, Applicants assert that claims 1-5 and 7-19 are allowable for at least these additional reasons over the cited combination.

Applicants assert that claims 1-5 and 7-19 are in condition for allowance. Applicants request that the §103 rejections to these claims be withdrawn based on the remarks above and further request that an indication of allowable subject matter be provided. Should the Examiner have any questions, please contact the undersigned.

No fees are believed due beyond the fee for the Notice of Appeal and the fee for the extension of time. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

Date: April 24, 2006



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